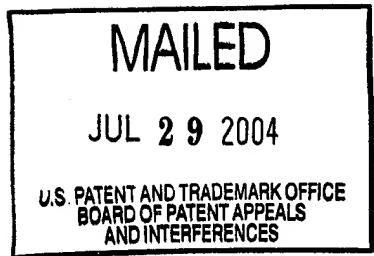


UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte MATTHEW S. KISSNER
and
KEVIN S. WEISS

Application No. 09/729,394

ORDER RETURNING UNDOCKETED APPEAL

This application was received at the Board of Patent Appeals and Interferences on June 18, 2004. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith returned to the examiner. The matters requiring attention prior to docketing are identified below.

On page 2 of the Examiner's Answer mailed February 2, 2004 (Paper No. 14), the examiner listed the following reference under the heading "(9) Prior Art of Record";

5,909,373 Sansome et al 6-1999

It is noted that the Walker and Engel references cited on pages 4 and 5 of the Examiner's Answer under the heading "Grounds of Rejection" are not included as "Prior Art of Record." In accordance with § 1211 of the Manual of Patent Examining Procedure (MPEP) (8th Ed., Rev. 1, Feb. 2003), clarification is required regarding the pertinence of the Walker and Engel references.

In addition, MPEP § 1208(A)(9) states:

(A) REQUIREMENTS FOR EXAMINER'S ANSWER.
The examiner's answer is required to include,
under appropriate headings, in the order
indicated, the following items:

(9) References of Record. A listing of the references of record relied on, and, in the case of nonpatent references, the relevant page or pages.

If appropriate, compliance with MPEP § 1208(A)(9) is required in listing the Walker and Engel references under the heading "Prior

"Art of Record" appearing in the Examiner's Answer mailed February 2, 2004 (Paper No. 14).

A further review of the application indicates that the Notice of Appeal filed August 21, 2003 (Paper No. 10) and the Appeal Brief filed October 21, 2003 (Paper No. 11) (with additional copies of original Appeal Brief filed December 9, 2003 (Paper No. 13)) state that claims 1-10 and 12-18 are on appeal.

MPEP § 1208(A)(10) states:

(A) REQUIREMENTS FOR EXAMINER'S ANSWER.
The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

...
(10) Grounds of Rejection. For each ground of rejection applicable to the appealed claims, an explanation of the ground of rejection, or reference to a final rejection or other single prior action for a clear exposition of the rejection.

The Examiner's Answer mailed February 2, 2004 (Paper No. 14) does not comply with the above requirement since claims 9, 12, 17 and 18 were not included as part of any rejection. Correction is required.

Lastly, section 1208 of the MPEP states:

On the examiner's answer, below the primary examiner's signature, the word "Conferees:" should be included, followed by the typed or printed names of the other two appeal conference participants. These two appeal conference participants must place their initials next to their name. This will make the record clear that an appeal conference has been held. [Emphasis added.]

The Examiner's Answer mailed February 2, 2004 (Paper No. 14) does not comply with the above requirement.

Accordingly, it is

ORDERED that the application is returned to the Examiner:

1. for clarification under MPEP § 1211 regarding the pertinence of the Walker and Engel references listed on pages 4 and 5 of the Examiner's Answer mailed February 2, 2004 (Paper No. 14);
2. if appropriate, for compliance with MPEP § 1208(A)(9) by listing the Walker and Engel references in a Supplemental Examiner's Answer under the heading "References of Record";
3. for proper response to the "Grounds of Rejection" appearing on pages 3-5 of the Examiner's Answer mailed

February 2, 2004 (Paper No. 14) by including claims 9, 12, 17 and 18 in a rejection;

4. for taking corrective action regarding the appeals conference;

5. for notification to appellants regarding the action taken; and

6. for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By:


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